

**RECEIVED
CENTRAL FAX CENTER**

JUN 26 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Auerbach)	Art Unit: 2651
Serial No.: 10/786,692)	Examiner: Slavitt
Filed: February 25, 2004)	HSJ920030241
For: SYSTEM AND METHOD FOR CORRECTING FOR HEAD TILT IN HDD)	June 26, 2005
)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

RESPONSE TO OFFICE ACTION

In response to the Office Action dated June 22, 2005, the allowance of Claims 1-6 and 12-17 and indicated allowability of Claims 8-11 is gratefully acknowledged.. Claim 7 has been rejected for obviousness-type double patenting over co-pending U.S. patent application serial no. 10/787,668. The '668 application was filed after this application, and hence the patent term of this application cannot extend beyond that of the '668 application unless the '668 application term is extended, an event that is unlikely given that the examiner has indicated its allowability and it has been pending less than eighteen months. Thus, there is no reason of record that the rationale for obviousness-type double patenting - to prevent unfair extensions of the patent term - is present, and indeed on the record it appears that it cannot be present, since this application was filed before the soon-to-be-allowed '668 application.

A comment appears in the Office Action that the specification should mention the '668 application, citing Rule 56 (Duty of Disclosure). First, the examiner is aware of the '668 application; there is no duty to disclose to an examiner that which he already is aware of, and in any case, the specification is not the place to do it. In fact, Applicant has terminally disclaimed the '668 application in response to an obviousness-type

CASE NO.: HSJ920030241
Serial No.: 10/786,692
June 26, 2005
Page 2

PATENT
Filed: February 25, 2004

double patenting rejection in the '668 application based on this application and levied by the present examiner, who thus is intimately familiar with both applications.

However, Applicant is grateful that the Examiner raised the point, because a review of the record indicates that the Form 892 which accompanies the Office Action fails to indicate that the '668 application has been cited in this prosecution. It is requested that another Form 892 be generated citing the '668 application for the record.

Regarding the reasons for allowance, Applicant would like to point out that while Applicant agrees that the claims indeed are allowable, it is not legally rigorous to identify only one of three elements as being "distinguishing" when it is axiomatic that the claim as a whole defines the patentable subject matter. Moreover, while the dependent claims inherit their parents' patentability, it must not be construed from their lack of mention in the reasons for allowance that the various dependent claim limitations do not possess additional patentability of their own beyond that of the base claims.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,


John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg

1189-19.AMD